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EXAMINER

HOEY, ALISSA L

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARBARA JENNINGS

Appeal 2008-1888
Application 10/693,129
Technology Center 3700

Decided: March 20, 2009

Before ERIC GRIMES, LORA M. GREEN, and
RICHARD M. LEOVITZ, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

DECISION ON REHEARING

Appellant requests a rehearing under 37 C.F.R. § 41.52(a)(1) of our Decision entered July 29, 2008 (“Decision”) in which we affirmed the Examiner’s final rejection of claims 2, 3, 5-7, 13, 14, 18, and 21 as anticipated and obvious in view of Jennings (U.S. Pat. No. 6,230,329 B1, May 15, 2001).

The claims

Claim 21, the only independent claim on appeal, is directed to a garment to be “used by a caregiver to manipulate a patient.” The garment has front and back “garment portions” and “a right tail portion and a left tail portion forming a garment body interconnection” between the front and back portions. The tail portions “pass[] through the groin area of said patient to anchor said garment” to the patient’s body.

The Specification describes two different “tail” embodiments. Figures 1, 2, 7A, and 8B show “double tail” embodiments; Figures 11A and 12B show “single tail” embodiments (Spec 4:19 to 6:12; Decision 4). Figures 2 and 12B are representative and reproduced below:

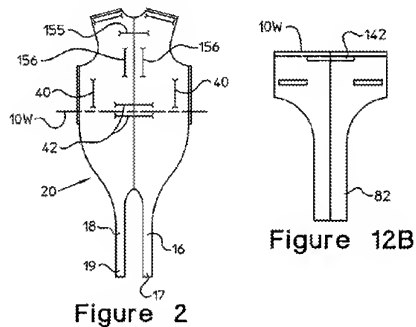


Figure 2 shows a double tail garment; Figure 12B shows a single tail garment.

Background

The claims were rejected by the Examiner as unpatentable over the Jennings patent (Decision 2). It was undisputed that Jennings described a

garment with a single elongated flap (FF¹1-3) – a structure similar to Appellant’s single tail embodiment as illustrated above in Figure 12B. The Examiner’s position in the Answer was that the elongated tail flap of Jennings’ garment had “a right tail portion” and “a left tail portion” as recited in claim 21 (Decision 3). Appellant argued that the Examiner improperly interpreted the single tail flap described by Jennings to have right and left portions. Thus, we stated the issue in the appeal to be as follows: Did the Examiner err in finding that the tail flap on Jennings’ garment has “a right tail portion” and “a left tail portion” as in appealed claim 21? (*id.*)

Giving “portion” its broadest reasonable interpretation in light of the Specification, we determined that the phrase would be understood by persons of ordinary skill in the art to mean “a part of the garment” (*id.* at 5). Thus, we concluded:

“tail portion” as recited in claim 21 would reasonably be understood by persons of ordinary skill in the art to read on: (1) the double tail embodiment, where each “portion” is a discrete part or tail of a two tailed garment and (2) the single tail embodiment where “portion” refers to the left-side and right-side parts of the single tail. With regard to (2), Figure 12B shows a single tail with left and right portions demarcated by a line through the middle.

(*Id.*). Based on this interpretation, we found that Jennings’ single elongated tail with right and left sides met the limitations of claim 21 of “a right tail portion and a left tail portion” (FF4-7).

¹ FF refers to the “Findings of Fact” in the Decision.

Request for Rehearing

In this Request for Rehearing, Appellant contends that the Board “overlooked or misapprehended the fact that Applicant[’]s claim 21 recites ‘a right tail portion and a left tail portion’ of the ‘garment body’ not of the flap in the Jennings” patent (Req. Reh’g 2). As argued in the Appeal Brief, Appellant once again repeated her position that the Jennings patent does not describe a “tail portion,” and that the claim language was improperly construed “by writing the terminology of” appealed claim 21 “into the disclosure of the Jennings” patent (*id.*). Appellant contends the “resort to a dictionary has served to define a term [“portion”] outside the applicant’s field of art and inconsistent with the applicant’s explicit description and illustrations of the claimed structure. Applicant’s specification will not allow an interpretation of a single tail” (*id.* at 4).

Issue

Did we err in our interpretation of claim 21 by construing the claim inconsistently with the Specification of which the claim is part?

Principles of Law

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.

In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

“Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their

interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation." *Morris*, 127 F.3d at 1056.

The PTO should not "limit broad claim terms solely on the basis of specification passages. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)." *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

[T]he PTO gives a disputed claim term its broadest reasonable interpretation during patent prosecution. [In *re Hyatt*, 211 F.3d 1367, 1372.] The "broadest reasonable interpretation" rule recognizes that "before a patent is granted the claims are readily amended as part of the examination process." *Burlington Indus. v. Quigg*, 822 F.2d 1581, 1583 (Fed. Cir. 1987). Thus, a patent applicant has the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application. *In re Prater*, . . . 415 F.2d 1393, 1404-05 (CCPA 1969). Additionally, the broadest reasonable interpretation rule "serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Yamamoto*, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984)).

Bigio, 381 F.3d at 1324.

Analysis

Our interpretation of claim 21 is not inconsistent with the Specification. We also applied the correct legal standard for claim construction.

On pages 4-5 of the Decision, we addressed the disclosure in the Specification, finding that the phrases "right tail portion" and "left tail portion" were not explicitly defined in it (Decision 4). Appellant has not challenged this finding.

In the Decision, we stated that “the tails of both the double tail and single tail embodiments are described as ‘portions’ of the garment (Spec. 14:8-9) apparently because they are part of and extend outwardly from the garment body” (Decision 4-5). Consistent with this usage, we adopted a general purpose dictionary meaning of “portion” to indicate a part of a garment (*id.* at 5) and then concluded it was reasonable to interpret the claim to cover the right and left sides of Jennings’ single tail embodiment (*id.*).

Appellant has not explained why our interpretation of “tail portion” to read on two sides of a single tail is inconsistent with the Specification. Appellant quotes at length from the Specification (Req. Reh’g 2-3), including some of the same sections cited on page 4 of the Decision. We acknowledge that the Specification in these passages uses the phrase “tail portion” to refer to each discrete tail of the double tail embodiment. However, claims are not limited solely on the basis of specification passages. *Bigio*, 381 F.3d at 1325. As pointed out in the Decision, the Specification also describes a specific embodiment with a single tail as in the Jennings patent and uses the term “portion” to characterize it (Spec. 14:8-9; Decision 4). “Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO’s definition unreasonable when the PTO can point to other sources that support its interpretation.” *Morris*, 127 F.3d at 1056. Appellant contends, but has proffered no evidence that, our interpretation is unreasonable or “outside” the field of art (Req. Reh’g 2-3).

In the Specification, “single tail” and “double tail” garments are described (Spec. 7:20 to 8:9) (Decision 4), but claim 21 recites a garment

having a “right tail portion” and a “left tail portion” (Decision 4). There is no evidence in this record that the right and left portions would be understood by a person of ordinary skill in the art having read the Specification to be synonymous with, and limited to, the “double tail” garment described in the Specification. A patent applicant has the “opportunity and responsibility to remove any ambiguity in claim term meaning” by amending claims during the examination process. *Bigio*, 382 F.3d at 1324. For this reason, the courts have steadfastly stuck to the “broadest reasonable interpretation” rule.

CONCLUSION OF LAW

We have considered Appellant’s Request for Rehearing, but decline to modify our original Decision entered July 29, 2008.

REHEARING DENIED

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